

REMARKS

Applicants have studied the Office Action dated May 15, 2003 and have made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-24 are currently pending in the present application. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks are respectfully requested. In the Office Action, the Examiner:

- (6) objected to the specification because it contains an embedded hyperlink and/or other form of browser-executable code on page 8;
- (7-8) rejected claims 1-3, 5, 7-16, and 21-24 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467), and in further view of Gennaro et al (US 5,937,066 A);
- (9) rejected claims 4 and 6 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467) and in further view of Gennaro et al (US 5,937,066 A) as applied to claim 1 above, and further in view of CableVision (periodical);
- (10) rejected claims 17 - 19 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467) and in further view of Gennaro et al (US 5,937,066 A) as applied to claim 7 above, and further in view of Horstmann (US 6,009,401); and
- (11) rejected claim 20 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467) and in further view of Gennaro et al (US 5,937,066 A) and further in view of Horstmann (US 6,009,401) as applied to claim 19 above, and further in view of CableVision (periodical).

(6) Hyperlink

The specification has been amended to remove the hyperlink as suggested by the Examiner. No new matter has been added.

Disqualification of Gennaro Reference as Commonly Owned Art

Further, 1-24 are rejected under 35 U.S.C. § 103 as being unpatentable over Dillon '911 in view of Dillon '467, and in further view of Gennaro with various combinations of Horstmann (US 6,009,401) and CableVision (periodical). Applicants respectfully assert that the reference to Gennaro should be disqualified per 35 U.S.C. 103(c). In accordance with 35 USC 103(c) and MPEP 706.02(1)(2), the undersigned attorney makes the following statement:

Application 09/487, 417 and Patent 5,937,066 were, at the time the invention of Application 09/487,417 was made, owned by International Business Machines Corp.

This statement is sufficient evidence to disqualify Patent 5,937,066 from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application 09/487,417. In response, withdrawal of the rejection of 1-24 is respectfully requested.

(7-8) Rejection Under 35 U.S.C. §103(a) applying Dillon in view of Dillon in view of Gennaro

As noted above, the Examiner rejected claims 1-3, 5, 7-16, and 21-24 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467), and in further view of Gennaro et al (US 5,937,066 A). Independent claims 1, 7, 19, and 21 have been amended to distinguish over Dillon '911 taken alone and/or in view of Dillon '467 and/or Gennaro. Dillon '911 teaches an encrypted communications channel as opposed to encrypted content. The teaching of encrypting a pipe or communications channel is not the same as encrypting the content itself. In the present invention any broadcast channel and equipment can be used because the content is encrypted and not the communications channel is not encrypted. In contrast Dillon '911 explicitly teaches that each packet is encrypted. See Dillon '911 at col. 6, lines 56-60; or in the words of Dillon '911 "*The document is packetized, encrypted, and broadcast over communications link 140.*" This sequence is important because Dillon '911 is teaching encrypting the packetized documents i.e. "encrypted packets", this is different than the present invention where "wherein at least the second broadcast channel is not encrypted." The present invention permits current broadcast channels to send

encrypted content. This is not possible with the system as taught by Dillon '911. See Dillon '911 at least at col. 2, lines 9-37, col. 6, line 59, col. 9, line 6 where "encrypted packets" are explicitly taught.

Turning to Dillon '467 the same type of encryption (i.e. encryption of the channel not the encrypting of the content) is taught at least at col. 6, lines 56-59; col. 15, lines 53-62. Further Gennaro also teaches encrypted communications not encrypted content where the pipe is encrypted. See Gennaro at col. 4, lines 47-52, col. 14, lines 10-30. Accordingly, independent claims of the present invention distinguish over Dillon '911 taken alone and/or in view of Dillon '467 and/or in further view of Gennaro for at least this reason.

Moreover, the Federal Circuit has consistently held that when a §103 rejection is based upon a modification of a reference that destroys the intent, purpose or function of the invention disclosed in the reference, such a proposed modification is not proper and the *prima facie* case of obviousness can not be properly made. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here the intent, purpose and function of Dillon '911 taken alone and/or in view of Dillon '467 and/or in view of Gennaro is the use of "encrypted data packets", in contrast the intent and purpose of the present invention is "wherein at least the second broadcast channel is not encrypted." The present invention unlike the Dillon '911, Dillon '467 and/or Gennaro eliminates the need to have a specialized encrypted broadcast channel. This makes it possible to integrate the present invention with all preexisting non-encrypted broadcast technologies such as cable television and network broadcast television. In the present invention, once the encrypted content leaves the content provider/owner, the encrypted content can be moved across open, unprotected, unencrypted channels. No special broadcast or receiver equipment is needed as required by the references. This combination, as suggested by the Examiner, destroys the intent and purpose of Dillon '911 taken alone and/or in view of Dillon '467 and/or in view of Gennaro is the use of "encrypted packets". Accordingly, the present invention is distinguishable over Dillon '911 taken alone and/or in view of Dillon '467 and/or in view of Gennaro for this reason as well.

For the foregoing reasons, independent claims 1, 7, 19, and 21 as amended distinguish over Dillon '911 in view of Dillon '467. Claims 2-3, 5, 8-16, and 22-24 depend from claims 1, 7, and 21 respectively, since dependent claims contain all the limitations of the independent claims; claims 2-3, 5, 8-16, and 22-24 distinguish over Dillon '911 taken alone and/or in view of Dillon '467 and/or Gennaro, as well, and the Examiner's rejection should be withdrawn.

(9) Rejection Under 35 U.S.C. §103(a) applying Dillon, Dillon, Gennaro in view of CableVision

As noted above, the Examiner rejected claims 4 and 6 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467) and in further view of Gennaro et al (US 5,937,066 A) as applied to claim 1 above, and further in view of CableVision (periodical). Independent claim 1 has been amended to distinguish over Dillon '911 taken alone and/or in view of Dillon '467 and/or in view of Gennaro as described above. The Examiner goes on to combine CableVision(periodical).¹ The Cablevision reference nowhere suggests or teaches encrypting the content versus encrypting the pipe using "encrypted packets." Accordingly, claim 1 of the present invention distinguishes over Dillon '911 in view of Dillon '467, and Gennaro and further in view of Cablevision(periodical) for at least this reason. Claims 4 and 6 depend from claim 1, since dependent claims contain all the limitations of the independent claims, claims 4 and 6 distinguish over Dillon '911 taken alone and/or in view of Dillon '467 and/or in view of Gennaro, and further in view of Cablevision(periodical) as well, and the Examiner's rejection should be withdrawn.

(10) Rejection Under 35 U.S.C. §103(a) applying Dillon, Dillon, Gennaro in view of Horstmann

As noted above, the Examiner rejected claims 17-19 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467) and in further view of Gennaro as applied to claim 7 above, and further in view of Horstmann (U.S. 6,009,401). Independent claim 1 has been amended to distinguish over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467)

¹ Applicants make no statement whether such combination is even proper.

as described above. The Examiner goes on to combine Horstmann.² Horstmann nowhere suggests or teaches encrypting the content versus encrypting the pipe using "encrypted packets." Accordingly, claim 7 of the present invention distinguishes over Dillon '911 in view of Dillon '467 and Gennaro, and further in view of Horstmann. Claims 17-19 depend from claim 7, since dependent claims contain all the limitations of the independent claims, claims 17-19 distinguish over Dillon '911 taken alone and/or in view of Dillon '467 and/or Gennaro, and further in view of Horstmann as well, and the Examiner's rejection should be withdrawn.

Continuing further, the player application in Horstmann must go out to query a permissions server in order to open a in the present invention. In contrast the permissions in the present invention is stored as part of the promotional data. The present invention does not need to check with a permissions server to access the encrypted content. Accordingly, the present invention distinguishes over Horstmann for this reason as well.

(11) Rejection Under 35 U.S.C. §103(a) applying

Dillon, Dillon, Gennaro, Horstmann and CableVision

As noted above, the Examiner rejected claim 20 under 35 U.S.C. § 103 as being unpatentable over Dillon (U.S. 6,337,911) in view of Dillon (U.S. 6,351,467) and in further view of Gennaro et al (US 5,937,066 A) and further in view of Horstmann (US 6,009,401) as applied to claim 19 above, and further in view of CableVision (periodical). Independent claim 19 has been amended to distinguish over Dillon '911 and/or in view of Dillon '467 and/or in further view of Gennaro and further in view of Horstmann as described above. The Examiner goes on to combine CableVision (periodical).³ The Cablevision reference nowhere suggests or teaches encrypting the content versus encrypting the pipe using "encrypted packets." Accordingly, claim 1 of the present invention distinguishes over Dillon '911 in view of Dillon '467, and Gennaro and further in view of Cablevision(periodical) for

² Applicants make no statement whether such combination is even proper.

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at least this reason. Claim 20 depends from claim 19; since dependent claims contain all the limitations of the independent claims, claim 20 distinguishes over Dillon '911 taken alone and/or in view of Dillon '467 and/or in view of Gennaro, and/or in view of Horstmann and/or further in view of Cablevision(periodical) as well, and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to effect the patentability of the claims as amended.

In this Response, Applicants have amended certain claims. In light of the Office Action, Applicants believe these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicants respectfully submit that the claim amendments do not limit the range of any permissible equivalents.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR § 1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment is limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

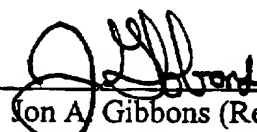
Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if this would expedite the prosecution of this application.

Respectfully submitted.

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By: _____



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